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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/197,080 | 11/20/1998 | GALEN C. HUNT | 3382-51187 | 9889 |

7590 06/30/2004

KLARQUIST SPARKMAN CAMPBELL LEIGH AND
WHINSTON
ONE WORLD TRADE CENTER
121 S W SALMON ST
PORTLAND, OR 97204

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| EXAMINER |
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PATEL, HARESH N

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| ART UNIT | PAPER NUMBER |
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2154

21

DATE MAILED: 06/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application

09/197,080

Applicant(s)

HUNT, GALEN C.

Examiner

Haresh Patel

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 April 0204.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
4a) Of the above claim(s) 46-60 is/are withdrawn from consideration.
5) ☒ Claim(s) 16-18 and 20-45 is/are allowed.
6) ☒ Claim(s) 1-15 and 19 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Art Unit: 2154

DETAILED ACTION

1. Claims 1-60 are presented for examination.

Double Patenting

2. The nonstatutory double patenting is withdrawn considering the applicant filed terminal disclaimers, paper numbers 18 and 19.

Election/Restrictions

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 46-60, are drawn to “accessing any existing application and network profiles and analyzing the profiles in a distributed computing environment for distribution”, classified in class 709, subclass 217
 - II. Claims 1-45, are drawn to “profiling and then reconfiguring an application having specific contents using the network characteristics”, classified in class 719, subclass 316.

Newly submitted claims 46-80 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Invention I has separate utility such as lacking “profiling and then reconfiguring an application having specific contents using the network characteristics”, particulars.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution

Art Unit: 2154

on the merits. Accordingly, claims 46-80 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

5. Because these inventions are distinct for the reasons given above and the extensive search required for one group is not required for the other groups, restriction for examination purposes as indicated is proper.

6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-15 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by applicant's admitted prior art (AAPA) as disclosed in disclosed in the non-final action, paper number 14, 10/29/2003.

Response to Arguments

9. Applicant's arguments filed 4/2/04, paper number 17, have been fully considered but they are not persuasive.

Applicant argues (1) "examiner has incorrectly combined at least five separate systems into a single reference labeled AAPA". The examiner disagrees in response to applicant's arguments. AAPA stands for applicant's admitted prior art, which is used as a single reference for the well-known prior art concept provided by the applicant. Rejected claims under AAPA are not limited to any one single system, hence the well-known concept admitted by the applicant in the disclosure, i.e., AAPA, is used as a single primary reference for the rejection of the claims. Therefore examiner believes that the concept provided by the AAPA is indeed proper rejection under 102(b).

Applicant argues (2) "although the examiner has not rejected claims 1-15 and 19 under 35 USC 103 and has not provided a motivation to combine the different systems described in the background, the examiner has mapped features from the different systems to claim 1". The examiner disagrees in response to applicant's arguments. AAPA stands for applicant's admitted prior art, which is used as a single reference for the well-known prior art concept provided by the applicant. Rejected claims under AAPA are not limited to any one single system, hence the well-known concept admitted by the applicant in the disclosure, i.e., AAPA, is used as a single

Art Unit: 2154

primary reference for the rejection of the claims. Therefore examiner believes that the concept provided by the AAPA is indeed proper rejection under 102(b).

Applicant argues (3) "ICOPS, CAGES, and IDAP, taken separately or in combination, do not teach or suggest the claimed limitation of claim 1, ..., and also leads away from the language of claim 1". The examiner disagrees in response to applicant's arguments. AAPA stands for applicant's admitted prior art, which is used as a single reference for the well-known prior art concept provided by the applicant. Rejected claim 1 under AAPA is not limited to any one single system, hence the well-known concept admitted by the applicant in the disclosure, i.e., AAPA, is used as a single primary reference for the rejection of the claims. Therefore examiner believes that the concept provided by the AAPA is indeed proper rejection for claim 1.

Applicant argues (4) "the examiner may be modifying the ICOPS, IDAP, or CAGE system with some feature of DCOM, CORBA, or another technology to create a system with generating a structural metadata description from a type file, ..., it would change the principal of operation of the ICOPS, IDAP, or CAGES system". The examiner disagrees in response to applicant's arguments. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies ("the examiner may be modifying the ICOPS, IDAP, or CAGE system with some feature of DCOM, CORBA, or another technology to create a system with generating a structural metadata description from a type file, ..., it would change the principal of operation of the ICOPS, IDAP, or CAGES system", i.e., the concept of claimed limitation limited to a particular system only) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van*

Art Unit: 2154

Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Therefore the rejection is maintained as disclosed above.

Allowable Subject Matter

10. Claims 16-18, are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. Claims 20-45 are allowed.

The following is an examiner's statement of reasons for allowance:

No other prior art teaches combining the generated application profile with the characteristics of the network (i.e. network profile) and then to further analyze and generate the distribution plan.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See Form PTO-892.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 2154

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Haresh Patel whose telephone number is (703) 605-5234. The examiner can normally be reached on Monday-Friday from 8:00 am to 5:30 pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee, can be reached at (703) 305-8498.

The appropriate fax phone number for the organization where this application or proceeding is assigned is (703) 306-5404.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Haresh Patel

June 23, 2004


JOHN FOLLANSBEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100